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Novartis Institutes for BioMedical Research, Inc. **MAILED**

265 Franklin Street

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MAR 24 2010

In re Patent No. 7,582,624

: DECISION ON REQUEST FOR

Carter et al.

: RECONSIDERATION OF

Issue Date: September 1, 2009

: PATENT TERM ADJUSTMENT

Application No. 10/528,250

: AND NOTICE OF INTENT

Filed: June 21, 2005

: TO ISSUE CERTIFICATE OF

Attorney Docket No. NV2-

: CORRECTION

023USRCE

:

Title: Benzodiazepine

:

Derivatives and Pharmaceutical

:

Compositions Containing Them

:

OFFICE OF PETITIONS

This is a decision on the petition filed on September 4, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by two hundred seventy-four (274) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED to the extent indicated herein.**

The patent is entitled under 37 CFR 1.702(a) to 269 days.

Patentees calculated the "B" delay period based on the date the application papers were deposited in the Office March 17, 2005. However, in an international application, this period is based on the failure of the Office to issue a patent within three years after the national stage commenced under 35 U.S.C. 371(b) or (f). See 1.702(b).

The priority date of this application is September 20, 2002. As a request for early commencement was not made, and March 20, 2005 fell on a weekend, the national stage commenced in this application on March 21, 2005. Thus, the "B" delay is 243 days,

counting the number of days beginning on March 22, 2008 and ending on November 19, 2008, the day before the filing of the request for continued examination (RCE). See 1.703(b). As the period from the filing date of the RCE to the issue date of the patent is not included in the "B" delay period, the over three year period began on March 22, 2008 and ended on November 19, 2008, the day before the RCE was filed, and is 243 days. See 35 U.S.C. 154(b)(1)(B)(i). There are zero days of overlap between 37 CFR 1.702(a) and 37 CFR 1.702(b).

As such the total number of days the period of adjustment under 37 CFR 1.702(a) and (b) must be reduced due to applicants' delay which totals 31 days.

The adjustment is further properly reduced 114 days pursuant to 37 CFR 1.703(b)(4) in connection with the Notice of Appeal filed July 29, 2008. The reduction commenced July 29, 2008, the date that the Notice of Appeal was filed, and ended November 19, 2008, the day before the request for continued examination (RCE) was filed. See, 37 CFR 1.703(b)(4).

In view thereof, the patent is entitled to an overall adjustment of 367 days (269 days under 37 CFR 1.702(a) + 243 days under 37 CFR 1.702(b) - 0 overlapping days - 114 days under 37 CFR 1.703(b)(4) - 31 days of applicant delay).

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136. See 37 CFR 1.323(a)(4).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by three hundred sixty-seven (367) days.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Charlema Grant at (571) 272-3215.

/ALESIA M. BROWN/

Alesia M. Brown
Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,582,624 B2

DATED : September 1, 2009

DRAFT

INVENTOR(S) : Carter et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 238 days

Delete the phrase "by 238 days" and insert – by 367 days--